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| 10/824,165 | 04/14/2004 | Timothy J. Kardosz | ERN-TSH-001 | 6340 |
| 25784 7590 05/13/2009 MICHAEL O. SCHEINBERG P.O. BOX 164140 AUSTIN, TX 78716-4140 | | | | |
| EXAMINER | | | | |
| WALTERS, RYAN J | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,165

Applicant(s)

KARDOSZ ET AL.

Examiner

RYAN J. WALTERS

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Objections

1. **Claim 21** is objected to because of the following informalities:

On line 17, insert "configured" between "position" and "to join".

Appropriate correction is required.

2. **Claim 26** is objected to because of the following informalities:

On line 2, "that" appears twice.

Appropriate correction is required.

3. **Claim 30** is objected to because of the following informalities:

On line 6, replace "assembly" with "assemble".

On line 8, replace "stud" with "studs".

Appropriate correction is required.

4. **Claim 31** is objected to because of the following informalities:

On line 3, delete ", the single alignment hole".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 21-32 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Claim 21** recites the following limitation:

"an alignment guide" in line 6.

It is unclear if this is referring to the first and second alignment features recited later (if so it should be plural).

8. **Claim 21** recites the following limitations:

"the arrangement" in line 3.

"the length" in line 8

"lengths specified by the data" in line 16 (note that lines 5-6 only recite the data including dimensions and locations, not lengths)

"the alignment marks" in line 17

"the alignment holes" in line 24

There is insufficient antecedent basis for these limitations in the claim.

9. **Claim 22** recites the following limitation:

"an item" in line 4.

It is unclear whether this item is one of the fasteners recited in claim 21, line 23 or an additional part.

10. **Claim 23** recites the following limitation:

"self-drilling screws" in line 2.

It is unclear whether this item is one of the fasteners recited in claim 21, line 23 or an additional part.

11. **Claim 24** recites the following limitations:

"the alignment holes" in line 17.

There is insufficient antecedent basis for these limitations in the claim.

12. **Claim 25** recites the following limitations:

"a first alignment hole" in line 2. (introduced twice)

"the centerline" in lines 2 and 3.

There is insufficient antecedent basis for these limitations in the claim.

13. **Claim 26** recites the following limitation:

"the connections" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

14. **Claim 27** recites the following limitation:

"the stud" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

15. **Claim 28** recites the following limitations:

"the length" in line 2.

"the stud" in line 2.

There is insufficient antecedent basis for these limitations in the claim.

16. **Claim 29** recites the following limitations:

"the number of screws" in line 2.

"the alignment hole that is next to the assembly tag" in line 3.

There is insufficient antecedent basis for these limitations in the claim.

17. **Claim 26-29** recite the following limitation:

"forming on the roll-forming machine an assembly tag" in line 1 of each.

There is insufficient antecedent basis for this limitation in the claims.

18. **Claim 30** recites the following limitation:

"the structural stuff members" in line 3.

There is insufficient antecedent basis for this limitation in the claim.

19. **Claim 31** recites the following limitations:

"the stud" in line 3.

"the connecting stud" in line 3.

There is insufficient antecedent basis for these limitations in the claim.

20. **Claim 32** recites the following limitation:

"the two alignment holes" in line 1.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

21. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

22. Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buers (US 5,715,642) in view of Ellis (US 6,813,919).

23. In regards to **Claims 21 and 30**, Buers discloses a method of making a truss 98 using back-to-back "C" channel studs without requiring the use of a jig (Fig. 6; Col. 3, lines 1-10), comprising: forming a first and second "C"-channel stud 60 using a roll-

forming machine (Col. 9, lines 58-65), the "C" channel studs 60 including a web 62, a flange 64, and a lip 68 (Col. 7, lines 44-58); forming, using the roll-forming machine in the first "C" channel, a first alignment feature 72, and in the second "C" channel, a second alignment feature 72 (Col. 9, lines 58-65; Col. 7, lines 55-58); juxtaposing the first and second "C"-channel studs 60 back-to-back with the web 62 of the first "C"-channel stud 60 contacting the web 62 of the second "C"-channel stud 60 such that the first and second alignment feature 72 are aligned (Figs. 6, 7; Col. 12, lines 1-13); and attaching the first and second "C"-channel studs 60 to each other using fasteners (Fig. 7; Col. 12, lines 1-13), the alignment holes formed by the roll-forming machine providing a way for aligning and attaching the first and second "C"-channel studs 60 without requiring a jig (Fig. 7; Col. 12, lines 1-13; Col. 3, lines 1-10).

Buers inherently discloses generating data identifying an arrangement of structural stud members in accordance with a truss design and identifying locations for alignment features since, as seen in Figs. 6 and 7, the studs fit together to form a truss utilizing the alignments features, which are specifically located to allow these various configurations (See Figs. 6-7). Buers teaches forming studs with the roll forming machine according to specific data including specific locations for alignment features (Fig. 7; Col. 9, lines 58-65; Col. 7, lines 55-58).

Buers does not disclose forming studs with the roll forming machine according to specific data including specific dimensions. However, **Ellis** teaches generating data to form studs with the roll forming machine according to specific data including specific dimensions and specific locations for alignment means and identifying the total amount

of studs needed to form the truss (Col. 5, lines 4-38). It would be obvious to one of ordinary skill in the art to generate data to form studs with the roll forming machine according to specific data, as taught by Ellis, for the purpose of creating customized frame assemblies to fit spaces having specified design characteristics which can be constructed conveniently and efficiently (Col. 5, line 27-32).

24. In regards to **Claim 22**, Buers discloses that the first alignment feature and the second alignment feature each comprises an alignment hole and in which juxtaposing the first and second "C"-channel studs 60 such that the first alignment feature 72 and the second alignment feature 72 are aligned includes inserting an item into the first and second alignment holes (Fig. 7; Col. 12, lines 1-13; Col. 4, lines 15-18).

25. In regards to **Claim 23**, Buers discloses attaching the "C"-channel studs to each other using self-drilling screws 120a, 120b, 124a, 124b (Fig. 7; Col. 4, lines 7-8 and 14-19).

26. In regards to **Claim 24**, claim 24 is identical to claim 21 with the additional limitation of forming an assembly tag on the first stud including information about assembling the stud to form the truss. Buers discloses applying assembly tags on the studs which identify the size, gauge, and length of a piece (Col. 1, lines 37-40); using the broadest reasonable interpretation this can be considered information about assembling the stud to form the truss. Buers does not teach using a roll forming machine to form the assembly tags. Further, the instant application teaches that conventional roll forming machines (which are well known in the art) can print assembly tags onto a member as the member is being formed (Page 8, paragraph 23). Therefore,

it would be obvious to one of ordinary skill in the art to provide information about assembling directly on the component in order to eliminate a need for a template or extensive instructions thus simplifying assembling procedures.

27. In regards to **Claim 25**, see 120a in Fig. 7, which lies on the centerline of the stud.

28. In regards to **Claim 26**, as best understood, Buers discloses forming holes on the piece which correspond to the possible connections for the stud and thus act as an assembly tag for specifying the connections for the stud (Fig. 7).

29. In regards to **Claim 27**, Buers discloses applying assembly tags on the studs which identify the length of a piece (Col. 1, lines 37-40) which inherently specifies the truss in which the stud can be used since it can be used in any truss.

30. In regards to **Claim 28**, Buers discloses applying assembly tags on the studs which identify the length of a piece (Col. 1, lines 37-40).

31. In regards to **Claim 29**, Buers discloses forming holes on the piece which correspond to the number of screws that can be used and thus act as an assembly tag for specifying the number of screws (Fig. 7).

32. In regards to **Claim 31**, Buers discloses forming a single alignment hole 120b (amongst other holes) at each end of the stud based on locations in the data, the holes being positioned for aligning connecting studs in the truss (Fig. 7).

33. In regards to **Claim 32**, note that alignment hole 120b is offset from a centerline of the stud (Fig. 7).

Response to Arguments

34. Applicant's arguments with respect to claim 21-25 have been considered but are moot in view of the new ground(s) of rejection.

35. Applicant argues on page 12 that Buers teaches minimizing inventory by using a standard stud and including a label on each stud would foil the purpose of Buers. Note that the information of the size, gauge, and length can be considered information about assembling the stud to form a truss since these are crucial factors that decide whether the studs can be used in the truss. The assertion that Buers would then need to inventory additional studs having different labels is not necessarily true since different sized studs could be formed by different roll forming machines with each machine only forming one particular size or length of stud.

36. Applicant's other arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. WALTERS whose telephone number is (571)270-5429. The examiner can normally be reached on Monday-Friday, 9am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. J. W./
Examiner, Art Unit 3726

/DAVID P. BRYANT/
Supervisory Patent Examiner, Art Unit 3726